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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ESER KANDOGAN and SHUMIN ZHAI

Appeal 2006-2955
Application 09/991,140
Technology Center 2600

Decided: January 9, 2008

Before MAHSHID D. SAADAT, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

SAADAT, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants request reconsideration of our Decision of March 29, 2007, wherein we sustained the Examiner's rejection of the appealed claims under 35 U.S.C. § 103.

We have carefully considered the arguments presented by Appellants in the Request and reviewed our decision. However, those arguments do not persuade us that our decision was in error in any respect or we have

overlooked any relevant points in reaching our decision that the Examiner properly rejected claims 1-37 under 35 U.S.C. § 103 as being unpatentable over the applied prior art.

1. Scope of the Claim

It is Appellants' belief that the Board has misapprehended the language of claim 1 by allowing "the user's finger or stylus" to mean "*the user's other finger*" (Req. Reh'g. 2, ¶ 2). Appellants argue that "the user's finger or stylus" must be the same finger or stylus used previously (Req. Reh'g. 2, ¶ 4). Appellants conclude that, as such, the methodologies of Stone are distinguished by claim 1 since the device of Stone is not usable with one finger (Req. Reh'g. 3, ¶ 2).

We disagree. The specific claim language related to "a user's finger or stylus" and "the user's finger or stylus" can in fact be interpreted as initially using a user's finger or stylus and later using the same user's finger or stylus. For example, the relevant portion of claim 1 reads as follows:

... by first selecting the first key with *a user's finger or stylus* and then selecting a key displaying the first marking with *a user's finger or stylus* ...
(Emphasis added.)

Thus, "the user's finger or stylus" could also mean "the *same* user's finger or stylus" and not necessarily "the user's same finger or stylus." While the claim may also be interpreted as using the same finger, the breadth of the claim allows the interpretation requiring only a finger of the same user. In view of the arguments made by Appellants, we are at loss as to why the

claims were not amended to clarify the specific configuration Appellants intend to attribute to the claimed user's finger or stylus.

We also disagree with Appellants that our interpretation is inconsistent with the established legal precedence (Req. Reh'g. 3, ¶ 1) or the claimed steps of selecting the characters necessarily require that the finger or the stylus can only be in one place at a time (Req. Reh'g. 3, ¶ 2). As explained in *In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997), Patent and Trademark Office (PTO) is not required, in course of prosecution, to interpret claims in patent applications in same manner as courts interpret claims during infringement suits. Instead, the PTO applies to the language of proposed claims the "broadest reasonable interpretation" or the meaning in their ordinary usage as they would be understood by one of ordinary skill in art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by written description in applicant's specification. Citing *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) and *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984). Appellants' intended interpretation of using the user's same finger and selecting characters in a sequential manner notwithstanding, the claims are not so limited.

Therefore, consistent with *In re Morris*, *supra*, we decline to accept the narrow interpretation argued by Appellants unless the claims clearly delimit the use of the user's finger or stylus to the same finger or stylus in a sequential selection. As such, taking the claim to encompass the concept of using "the *same* user's finger or stylus" is consistent with the ordinary

meaning of the terms and not unreasonable for this panel to assert that other fingers of the same user may be used for selection characters.

Appellants further argue that the claimed subject matter is inherently unsuitable for use with concurrent key selection technique of stone (Req. Reh'g. 4, ¶ 2) which may be applicable only to keyboards that can be used with concurrent actuations and may be considered obvious extensions of Stone (Request 4, ¶ 3). We disagree because, as discussed above, the claims do not preclude concurrent actuation of the keys.

Appellants further assert that based on the discussion previously presented in their Appeal Brief (pp. 9-16), the Stone's variations cannot overlap with the claimed subject matter (Req. Reh'g. 5, ¶ 1). Appellants argue that those arguments were not addressed by this panel and may have been overlooked (*id.*). We note that while the disclosed subject matter includes sequential key strokes, which were pointed out in Appellants' Brief, the claims do not require sequential key strokes.

With respect to the details of the key strokes sequence, we note that the teachings of Stone are not relied on for the exact sequence of key selections Appellants argue to be encompassed by the claims. In fact, Stone teaches the nature of the color or positional indicator for identifying which one of the multiple characters associated with a key is intended for selection. Appellants' view of Stone and how its teachings are applied in the rejection is very limiting and ignores the reference teachings as a whole such as the combination of keys and alternative ways of sequential or combinational key selections. The only option for a single key selection in Stone relates to

common characters that are more frequently used and benefit from fewer key strokes for ease of use (Stone, col. 3, ll. 44-59).

We also observe that Appellants' arguments related to the number of numerals on the keys and reliance on Appellants' Figure 10 (Req. Reh'g., 6-8) appear to be premised only on whether Stone teaches all of the claimed features. Stone provides the sequence of key selection by using color or positional indicator for selecting one of the pluralities of characters associated with each key while the specific arrangement of the characters and the positioning of characters and markings are suggested by the other applied prior art.

Accordingly, based on the state of the prior art as a whole, we remain of the opinion that it would have been obvious for one of ordinary skill in the art to combine Stone with Novel, Smith and Prame to provide for the key selection involving the extra characters associated with each key.

In conclusion, based on the foregoing, we have granted Appellants' request to the extent that we have reconsidered our decision, but we deny Appellants' request to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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